

BEST AVAILABLE COPYApplication No.: 10/646,373Docket No.: 700111202-2 US (1509-440)**REMARKS**

Applicant notes the allowance of claims 1-10, 14-15 and 19.

Claims 13, 18 and 22 have been amended to overcome the rejection thereof under 35 U.S.C. 101. The claims are now directed to statutory subject matter in the form of a computer readable medium or memory device, i.e., a new and useful "manufacture."

Applicant traverses the rejection of claims 11, 12, 16, 17, 20 and 21 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The examiner is apparently of the belief that claims 11, 12, 16, 17, 20 and 21 are indefinite because they define a system for performing a method defined by another claim. The Office Action states "it is not seen how a system claim can depend from a method claim."

The attention of the Examiner is directed to MPEP 2173.05(f) that states:

A claim which makes reference to a preceding claim to define a limitation is an acceptable claim construction which should not necessarily be rejected as improper or confusing under 35 U.S.C. 112, second paragraph. For example, claims which read: "The product produced by the method of claim 1," or "A method of producing ethanol comprising contacting amylase with the culture of claim 1 under the following conditions..." are not indefinite under 35 U.S.C. 112, second paragraph, merely because of the reference to another claim. See also *Ex parte Porter*, 25 USPQ2d 1144 (Bd. Pat. App. & Inter. 1992) where reference to "the nozzle of claim 7" in a method claim was held to comply with 35 U.S.C. 112, second paragraph.

Based on the foregoing, it is apparent that a claim in a first statutory class can refer to a claim in a second statutory class without having a per se violation of 35 USC 112, paragraph 2. In the present case, claims 11, 12, 16, 17, 20 and 21 are claims directed to systems (i.e., the statutory class referred to as a "machine") and claims 1 and 2 are method claims (i.e., the statutory class referred to as a "process"). MPEP §2173.05(f)

BEST AVAILABLE COPYApplication No.: 10/646,373Docket No.: 700111202-2 US (1509-440)

clearly indicates a claim on a new product can depend on a method claim, or a claim on a method of producing a composition of matter can depend on a claim on a composition and a claim on a method can depend on a product claim. There is no reason why a claim on a system that operates in a certain way can not depend on a claim that defines the operations.

MPEP §2173 states:

The primary purpose of this requirement of definiteness of claim language is to ensure that the scope of the claims is clear so the public is informed of the boundaries of what constitutes infringement of the patent. A secondary purpose is to provide a clear measure of what applicants regard as the invention so that it can be determined whether the claimed invention meets all the criteria for patentability and whether the specification meets the criteria of 35 U.S.C. 112, first paragraph with respect to the claimed invention.

The Office Action fails to indicate why the public would not be informed of applicant's invention by the language of claims 11, 12, 16, 17, 20 or 21 or why these claims do not provide a clear measure of what applicant regards as his invention. Consequently, the rejection of claims 11, 12, 16, 17, 20 and 21 under 35 U.S.C. 112, paragraph 2, is improper.

Allowance is in order.

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Application No.: 10/646,373

Docket No.: 700111202-2 US (1809-440)

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 08-2025 and please credit any excess fees to such deposit account.

Respectfully submitted,

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